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REMARKS

The Amendments

Claim 11 is amended to delete an extraneous period in the recited sequence.

Claim 16 is cancelled.

Claim 22 is amended by inserting the word "comprises", to correct a typographical error.

Claim 23 is amended to correct the spelling of "erythematosus".

No new matter is introduced by these amendments. Upon entry of the amendments, claims 11, 12, 14, 15, 17, and 19-25 will be pending.

35 USC 112, first paragraph

Claims 11, 12, 14-17, and 19-25 are rejected under 35 USC 112 first paragraph as failing to comply with the written description requirement. Specifically, the Examiner contends that the claim limitation that the nucleotides of the invention are "between 13 and 22" nucleic acids in length is not supported by the specification, which does not explicitly disclose 13-mers. Applicants respectfully traverse.

The Examiner contends that the limitation "between 13 and 22" that Applicants wish to introduce by amendment "essentially amounts to a negative limitation" for which the excluded element must find support in the specification (Office action of 10/31/2003, page 3). Assuming, for the sake of argument, that the Examiner's "negative limitation" analysis is appropriate, Applicants respectfully point out that what is excluded are 12-mers, not 13-mers, and 12-mers are specifically recited in the specification (e.g., SEQ ID NO: 13 is precisely 12 residues in length). As stated in the portion of the MPEP quoted by the Examiner, "If alternative embodiments are positively recited in the specification, they may be explicitly excluded in the claims." Because the amendment excludes an embodiment that is specifically recited, Applicant respectfully requests reconsideration and withdrawal of the objection.

In any event, Applicant respectfully submits that the question is moot. The phrase "between 13 and 22" was introduced into these claims (by the amendments of December 19, 2003) merely to render them in independent form. The expression "between 13 and 22" thus appears in the preamble to these claims, where it does not serve as a claim limitation at all; the

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claims are directed to the specific nucleotide sequences recited, and not to a plurality of species within the range of 13 to 22 nucleotides in length.

35 USC §102(a)

Claims 11, 12, 14, 15, 17, and 19-25 are rejected under 35 USC §102(a) as being anticipated by WO 96/24380. Applicant respectfully traverses, based on the principle that Applicant's disclosure of his own work within the year before the application filing date cannot be used against him under 35 U.S.C. 102(a). *In re Katz*, 687 F.2d 450, 215 USPQ 14 (CCPA 1982). A declaration of the inventor under 37 C.F.R. 1.131 is enclosed herewith, establishing that the present inventor is also the sole author of the cited reference and the sole inventor of the work described therein. In view of the declaration, reconsideration and withdrawal of the rejection under 35 USC §102(a) is respectfully requested.

35 USC §102(b)

Claim 16 is rejected under 35 USC §102(b) as being anticipated by WO 96/24380 ("Tam II"). Claim 16 has been cancelled in the present amendment.

35 USC §102(e)

Claims 11, 12, 14- 17, and 19-25 are rejected under 35 USC §102(e) as being anticipated by US 5,932,556 ("Tam I"). Applicant respectfully traverses, on the grounds that the work described in Tam I is not "by another" as required by 35 USC §102(e). Applicant is the sole inventor and sole applicant of Tam I and of its parent application, US 08/387,041, and has signed inventor's declarations to that effect in connection with those applications. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection under 35 USC §102(e).

Obviousness-Type Double Patenting

Claims 11, 16, 17, and 19-25 are rejected under the doctrine of obviousness-type double patenting, in view of US 5,932,556. Withdrawal of the rejection is requested, in view of the terminal disclaimer that was filed in connection with this application on March 18, 2003 and accepted by the Examiner in the Office Action dated May 7, 2003.

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CONCLUSION

Applicant respectfully submits that all grounds of rejection have been overcome by the present amendments and/or in view of the above remarks, and requests allowance of the claims listed herein. The Examiner is cordially invited to contact Applicant's undersigned agent by telephone if there are any questions or issues remaining.

Respectfully submitted,

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